



EXPRESS MAIL NO. EV447226590US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Nicolas Rougnon-Glasson
Application No. : 10/743,564
Filed : December 22, 2003
For : DEVICE FOR TRANSFERRING DATA BETWEEN
TWO ASYNCHRONOUS SUBSYSTEMS HAVING A
BUFFER MEMORY
Examiner : Tammara R. Peyton
Art Unit : 2182
Docket No. : 852263.410
Date : January 23, 2006

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents:

In response to the Election of Species Requirement dated November 22, 2005, please extend the period of time for response one month, to expire on January 22, 2006 (Sunday). Enclosed are a Petition for an Extension of Time and the requisite fee.

In response to the Species Election Requirement, the applicant hereby elects **with traverse** Species 2, claims 11-22, for examination at this time.

The applicant disagrees with the Species Election Requirement because claim 11 of Species 2 is not directed to a different species than claim 1 of Species 1. Instead, claim 11 is simply a broader claim that encompasses the invention recited in claim 1. In fact, claim 11 is substantially identical to claim 1 except that claim 11 does not recite the fourth shadow register and second compare circuit recited in claim 1. As such, claim 1 could be presented as a claim depending on claim 11 without any substantive change, and thus, claim 1 clearly cannot be directed to a different species than claim 11.

Claims 1 and 11 define the same essential features of a single disclosed embodiment of the invention and should not be subjected to an Species Election Requirement. Indeed, as stated in MPEP § 806.03:

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are *>not directed to distinct

inventions; rather they are< different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

The present application shows a single embodiment of the invention in Figure 5. Both claims 1 and 11 read on the same essential features of that embodiment and should not be subjected to an Species Election Requirement.

Claim 11 is clearly a generic claim to the Species recited in claim 1, and thus, claims 1 and 11 should be examined together. As stated in MPEP § 806.04(d):

**In general, a generic claim should *>require< no material element additional to those **>required by< the species claims, and ** each of the species >claims must require all the limitations of the generic claim<.

**

Claim 11 does not require any element additional to that required by claim 1 and claim 1 does require all of the limitations of claim 11. As such, they are not directed to patentably distinct species.

If the Examiner continues to require an election, the applicant respectfully requests allowance of claims 1-10 upon allowance of claim 11. As stated in MPEP § 806.04(d):

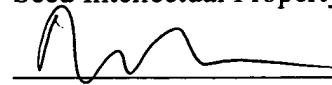
Once a **>generic claim is allowable<, all of the claims drawn to species in addition to the elected species which *>require< all the limitations of the generic claim will ordinarily be * allowable >over the prior art< in view of the *>allowability< of the generic claim, since the additional species will depend thereon or otherwise *>require< all of the limitations thereof. **

Given that claim 1 recites all of the elements of claim 11, claims 1-10 should be allowed upon allowance of claim 11.

In summary, the applicant submits that claims 1-10 and claims 11-22 in fact read on the same embodiment as described in the specification and shown in Figure 5. The applicant therefore respectfully requests that the Species Election Requirement be withdrawn.

Reconsideration of the Restriction and Species Election Requirements and consideration of the pending claims is now requested.

Respectfully submitted,
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